



UNITED STATES PATENT AND TRADEMARK OFFICE

CM
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/631,980

07/31/2003

Christopher J. Calhoun

MA9604P

2197

7590 04/10/2007
Stout, Uxa, Buyan & Mullins, LLP
Suite 300
4 Venture
Irvine, CA 92618

EXAMINER

BETTON, TIMOTHY E

ART UNIT

PAPER NUMBER

1614

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
|--|-----------|---------------|

3 MONTHS

04/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/631,980

Applicant(s)

CALHOUN ET AL.

Examiner

Timothy E. Betton

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 33-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3 sheets</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' election without traverse in the reply filed on 10 November 2006 is acknowledged.

Election of Species

Applicants hereby elect the invention of Group I, comprising Claims 1-32.

Status of the Claims

Claims 1-32 are pending for examination on the merits. Claims 33-52 are withdrawn.

Information Disclosure Citation

The International Search Report citation is lined through due to lacking a date of publication as required for a citation on a 1449. Such documents are not published and the date on the 1449 is therefore not a date of publication.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d

Art Unit: 1614

1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPq 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPq 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,673,362 B2.

Calhoun et al. (USPN 6,673,362 B2), a patent of patent application 10/385,399 which was filed 10 March 2003 is a resorbable thin membrane (34), which comprises uniform composition of a polymer capable of resorbing into the mammalian body for less than 24 months from an initial implantation of the membrane into the mammalian body. The polymer has a biased molecular orientation in the membrane that is biased, to at least one axis and has a viscosity of greater than 1 g/dL. The membrane is non-porous, and has two smooth surfaces and a thickness of 0.001-0.3 mm. The resorbable membrane are classified as surgical contexts, e.g. to retard or prevent tissue adhesions

Art Unit: 1614

or reduce scarring. The inventive resorbable thin membrane can retard or prevent tissue adhesions and reduce scarring. The scar-tissue reduction barrier membranes are constructed entirely of polylactide resorbable polymers, which are engineered to be absorbed into the body relatively slowly over time in order to reduce potential negative side effects. The scar tissue reduction barrier membranes are formed to have thicknesses on the order of microns, such as, for example, thicknesses between 10 and 300 microns. The membranes are pre-shaped with welding flanges and stored in sterile packaging. Although the conflicting claims are not identical in written disclosure, they are not patently distinct. The central elements are adequately encompassed and the central issue of invention is anticipated and obvious over subject invention. Calhoun et al. adequately anticipate instant claim 1 of subject invention which reads: A resorbable thin membrane comprising a substantially uniform composition comprising a polymer, the polymer being capable of resorbing into the mammalian body within a period less than about 24 months from an initial implantation of the membrane into the mammalian body, the polymer having a biased molecular orientation in the membrane that is biased to at least one axis and having a viscosity property that is greater than about 1 g/dL, the membrane having a first substantially-smooth surface and a second substantially-smooth surface, and the membrane being non-porous, and the membrane having a thickness of about 0.001 mm to about 0.300 mm as measured between the first substantially-smooth surface and the second substantially-smooth surface. Thus, current invention is rejected under the nonstatutory obviousness double patenting rejection because the methods of Calhoun et al. are obvious over the claimed invention.

Art Unit: 1614

Conclusion

. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy E. Betton whose telephone number is (571) 272-9922. The examiner can normally be reached on Monday-Friday 8:30a - 5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/1/07
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

TEB